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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/801,594

03/17/2004

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EXAMINER

NAQI, SHARICK

ART UNIT

PAPER NUMBER

3736

MAIL DATE

DELIVERY MODE

05/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/801,594	Applicant(s) FUNAHASHI, TAKESHI	
	Examiner Sharick Naqi	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 14, 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The examiner acknowledges the amendment filed February 14, 2007.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In both claims 18 and 19, regarding the limitation "...the medical information database manages the medical information of each patient of the plurality of patients collectively", it is unclear to the examiner where the limitation comes from within the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the term "collectively" in regards to claims 18 and 19 is indefinite. The term "collectively" is not defined in the specification or the

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dependent claims and is not sufficient to particularly point out and distinctly claim the metes and bounds of claims 18 and 19. The examiner has interpreted the applied prior art in a manner sufficient to reject the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by De La Huerga USPN 6,346,886.

1. A medical support system for supporting a medical care of a patient, comprising:

a wireless tag carried by each patient; (column 6, lines 1-38, column 8, lines 56-67, column 9, lines 1-33)

a medical information database operable to store medical information of each patient of a plurality of patients; and (column 6, lines 1-38, column 8, lines 56-67, column 9, lines 1-33)

a medical support apparatus operable to communicate with said wireless tag and said medical information database, said medical support apparatus comprising: (column 16, lines 17-40)

a patient ID acquisition unit operable to obtain a patient ID for identifying the patient from said wireless tag when the patient approached said medical support apparatus; (column 16, lines 17-40)

a suitability determination unit operable to refer to said medical information database and determine whether or not said medical support apparatus is suitable for the patient identified by the patient ID thus obtained; and (column 16, lines 17-40)
a warning unit operable to issue a warning to the patient when said suitability determination unit determined that said medical support apparatus was unsuitable for the patient. (column 17, lines 37-48)

Dependent claims 2-7 have been rejected on substantially the same basis. See previous action for details of the rejection.

8. A medical support apparatus for supporting a medical care of a patient, comprising:

a patient ID acquisition unit operable to obtain a patient ID for identifying the patient from a wireless tag carried by the patient when the patient approached said medical support apparatus; (column 6, lines 1-38)

a suitability determination unit operable to refer to a medical information database that stores medical information of each patient of a plurality of patients and determine whether or not said medical support apparatus is suitable for the patient identified by the patient ID obtained by the patient ID acquisition unit; and (column 8, lines 56-67, column 9, lines 1-33, column 16, lines 17-40, column 17, lines 23-36)

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a warning unit operable to issue a warning to the patient when said suitability determination unit determined that said medical support apparatus was unsuitable for the patient. (column 17, lines 37-48)

Independent claims 9 and 17, and dependent claims 10-16 been rejected on substantially the same basis. See previous action for details of the rejection.

18. A medical support system as claimed in claim 1, wherein the medical information database manages the medical information of each patient of the plurality of patients collectively. (column 8, lines 56-67, column 9, lines 1-33)

19. A medical support system as claimed in claim 8, wherein the medical information database manages the medical information of each patient of the plurality of patients collectively. (column 8, lines 56-67, column 9, lines 1-33)

Response to Arguments

Applicant's arguments filed February 14, 2007 have been fully considered but they are not persuasive.

In regards to claim 1, the applicant argues that, "De La Huerga fails to disclose all the features of claim 1." The examiner respectfully disagrees.

In response to applicant's argument that amended claim 1 recites "a wireless tag carried by each patient", the transponder disclosed by De La Huerga, in column 6, lines 1-38, is sufficient to meet the claim limitation.

In response to applicant's argument that amended claim 1 recites "a medical data base **operable to** store medical information of each patient of a plurality of patients", the applicant is respectfully reminded that "**operable to**" in the claims may properly be interpreted as "capable of" and "capable of" does not require that the reference actually teach the intended use of the element, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The memory device of De La Huerga disclosed in column 6, lines 1-38, which stores a patient's medical information and can be accessed via the transponder, is capable of storing medical information of each patient of a plurality of patients and is sufficient to meet the claim limitation.

However, even if the recitation is positively recited it is rejected because the prior art reference discloses the limitation. De la Huerga states in column 8, lines 56-67 and column 9, lines 1-33, that the memory device can be used to store the medical information of more than one patient. The disclosure is sufficient to reject the claimed invention.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

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(i.e., "De La Huerga fails to disclose how to manage the medical information of each patient.") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regards to claim 8, the applicant argues that, "claim 8 is patentable for analogous reasons presented above in conjunction with claim 1. The examiner respectfully disagrees.

In response to applicant's argument that amended claim 8 recites "a suitability determination unit **operable to** refer to a medical information database that stores medical information of each patient of a plurality of patients and determine whether or not said medical support apparatus is suitable for the patient identified by the patient ID obtained by the patient ID acquisition unit", the applicant is respectfully reminded that "**operable to**" in the claims may properly be interpreted as "capable of" and "capable of" does not require that the reference actually teach the intended use of the element, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. De la Huerga column 16, lines 17-40 and column 17, lines 23-36 discloses that the diagnostic or treatment device uses its transponder to interrogate the patient's transceiver to get identifying information from the memory device that stores medical information in order to check that it is the correct

patient for whom the procedure was ordered and ensures that the procedures are not performed on incorrect patients. The memory device is capable of storing medical information of each patient of a plurality of patients. The disclosure is sufficient to meet the claim limitation.

However, even if the recitation is positively recited it is rejected because the prior art reference discloses the limitation. De La Huerga states in column 8, lines 56-67 and column 9, lines 1-33, that the memory device can be used to store the medical information of more than one patient. The disclosure is sufficient to reject the claimed invention.

In regards to claim 9, the applicant argues that, "The feature of a diagnosis/treatment member's wireless tag is not disclosed." The examiner respectfully disagrees. De La Huerga discloses, in column 16, lines 17-40 and column 17, lines 37-48, that the diagnostic or treatment machine is equipped with a transponder for communication with the patient's transceiver. This disclosure is sufficient to meet the claim limitation of "a diagnosis/treatment member's wireless tag attached to a diagnosis/treatment member."

In regards to claim 17, the applicant argues that, "claim 17, is patentable for analogous reasons presented above in conjunction with claim 9." The examiner respectfully disagrees.

In response to applicants argument that claim 17 recites, "a diagnosis/treatment member ID acquisition unit **operable to** obtain a diagnosis/treatment member ID for identifying a diagnosis/treatment member from a diagnosis/treatment member's wireless tag attached to said diagnosis/treatment member when said diagnosis/treatment member approached said medical support apparatus sufficiently", the applicant is respectfully reminded that "**operable to**" in the claims may properly be interpreted as "capable of" and "capable of" does not require that the reference actually teach the intended use of the element, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The disclosure of De La Hueraga, column 17, lines 37-48, discloses that the patient's transceiver has an interrogation capability and the processor interrogates the diagnostic or treatment machine. This disclosure is sufficient to meet the claim limitation.

However, even if the recitation is positively recited it is rejected because the prior art reference discloses the aforementioned limitation. De La Hueraga discloses, in column 16, lines 17-40 and column 17, lines 37-48, that the diagnostic or treatment machine is equipped with a transponder for communication with the patient's transceiver. This disclosure is sufficient to meet the claim limitation of "a diagnosis/treatment member's wireless tag attached to said diagnosis/treatment member."

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharick Naqi whose telephone number is 571-272-3041. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SN
May 7, 2007

Max Hindenburg

A handwritten signature in black ink, appearing to read 'Max Hindenburg', written in a cursive style.